

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kenichiro Kosai

Application No.: 10/518,861

Filing Date: 03/21/2005

Group Art Unit: 1633

Examiner: Maria Gomez Leavitt

Attorney Dkt. No.: 042-301

Title: Method of Selective isolation or Visualization of Target Cells Differentiated from Embryonic Stem Cells or Kit for Visualization

AMENDMENT AND REQUEST FOR CONTINUED EXAMINATION  
AND PETITION TO REVIVE

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Commissioner:

November 25<sup>th</sup>, 2008

In response to the Official Action of February 22nd, 2008 and to the Advisory Action sent October 28<sup>th</sup>, 2008, please reconsider the application in light of the following amendments and remarks. Applicant believes that this application is currently abandoned and needs to be revived. Applicant originally responded to the Final Office Action within 2 months of receipt and expected to receive an Advisory Action soon thereafter. However, the Examiner did not respond with an Advisory Action until October 28<sup>th</sup>, 2008, over 2 months past the abandonment date. Therefore, the application effectively went abandoned.

Applicant would like to place in the record a formal comment addressing the Examiner's failure to timely respond to the Applicant's Final Office action response and the USPTO's rule for action after Final. The final states that "in the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, (the Examiner's advisory was not mailed until after the end of the SIX-MONTH statutory period), then the shortened statutory period will expire on the date the advisory action is mailed, (i.e., October 28, 2008) and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action (i.e., after the application has already been abandoned). In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.” Therefore, there should be no extension fees due because the extension fee starts from the date of mailing of the advisory action, in this case, after abandonment. Because of this there most likely is a revival fee due. Applicant believes that this rule is excessively Draconian as it typically forces the Applicant to pay early RCE fees due to the following reasoning.

Applicant believed that the application would be allowed with the response to the Final Office Action, or at least that Applicant would receive a timely Advisory Action setting out the reasons for disallowance. At that point Applicant would have been prepared to then file an RCE and pay the extension fees. However, because the Examiner did not send the Advisory Action until AFTER the final extension date Applicant was not aware of the Application status and was not given the opportunity to either timely reply to the Advisory Action or timely file an RCE in response to the Advisory Action and previously issued Final Office Action.

There are basically two distinct problems here. First, under MPEP 706.07 III PRACTICE AFTER FINAL, Subsection K states that “Replies after final should be processed and considered promptly by all Office personnel.” Applicant submits that processing and responding to Applicant’s first response to final (that was filed within two months of receipt of Final) after the SIX MONTH deadline and therefore after the application has been abandoned cannot and should not be considered “prompt”, as is required under the MPEP. Because of the requirement that responses be prompt, the MPEP more or less assumes that the Examiner will respond to the Applicant prior to the expiration of the SIX MONTH statutory deadline. The MPEP never once addresses the issue of an Advisory Action being mailed after the SIX MONTH statutory deadline that ultimately results in abandonment. If the Examiner does indeed respond prior to this SIX MONTH deadline then there would be no problems. However, in situations such as this where the Examiner fails to promptly respond there is a tendency for applications to go abandoned while waiting for receipt of an advisory action. This places a huge burden on the Applicant and sometimes undue additional costs to Applicant for revival all due to the fact that the Examiner fails to promptly respond.

Therefore, it is believed that this rule should be reconsidered by the USPTO. When the Examiner fails to "promptly" or timely reply to a Final that the Applicant should be given additional time after Advisory to file either a response to the Advisory that would place the application in condition for allowance or file an RCE. A reasonable time would be 30 days.

Therefore, as argued above, Applicant believes that no petition to extend the period for response is necessary but at this time and under present rules and regulations that it is necessary to revive the application and pay both the revival fee and the RCE fee. Should there be any deficiencies or need for further extension applicant hereby petitions for any necessary extension and authorizes the Director to charge applicant's charge account 50-2069 and to credit any overpayment to same account.